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In re Application of :
Stifter et al. :
Application No.: 10/587,176 : DECISION
PCT No.: PCT/AT05/00009 :
Int. Filing Date: 20 January 2005 : ON
Priority Date: 27 January 2004 :
Attorney Docket No.: 66376-387 : PETITION
For: Training Device For The
Muscles Of The Pelvic Floor :

This is in response to the petition under 37 CFR 1.47(a) filed on 15 June 2007.

BACKGROUND

This international application was filed on 20 January 2005, claimed an earlier priority date of 27 January 2004, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 04 August 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 27 July 2006. Applicants filed *inter alia* the basic national fee on 24 July 2006.

On 09 April 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding **requirement (1)**, the \$200.00 petition fee is being charged to Deposit Account No. 04-2223, as authorized by the petition.

Regarding **requirement (2)**, petitioner seeks relief under 37 CFR 1.47(a) on the basis that joint inventor Karl Stifter allegedly has refused to execute the application. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application

papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has provided copies of various German language documents, but it does not appear that English translations of all of these documents have provided (e.g., for the e-mail correspondence). The English translations of letters to Mr. Stifter which have been provided refer to, e.g., "previous correspondence" and to "the papers of the above application for signing," but do not in themselves establish that a complete copy of the application papers was provided to Mr. Stifter for his review in contemplation of executing this application. A statement signed by Michael Babeluk has been provided, and alludes to correspondence having been sent to Mr. Stifter, appearing to include a copy of the application and a declaration document. However, in the absence of English translations of all of the German language documents (including the e-mail purportedly evidencing a refusal), it would not be appropriate to conclude that requirement (2) has been satisfied at this time.

Regarding **requirement (3)**, the petition provides Karl Stifter's last known address. Accordingly, requirement (3) has been satisfied.

Regarding **requirement (4)**, the declaration of inventorship accompanying the instant petition is acceptable for purposes of entry into the national stage in the United States.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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